

REMARKS

Claims 13 and 15-23 are pending in this application. New claims 20-23 have been added to the application by this amendment.

The outstanding Office Action mailed on September 19, 2002 rejected claims 13 and 15-19 as being obvious over U.S. Patent No. 5,204,955 issued to Kagei. Applicants gratefully acknowledge the allowance of claim 14.

Information Disclosure Statement

An Information Disclosure Statement (IDS) was filed on September 17, 2002 to submit documents that had been cited in a counterpart foreign application. The IDS was filed just two days prior to the Office Action and was not considered in the Office Action. Applicants respectfully request that the IDS be considered in the next Office Action or Notice or Allowance.

Obviousness Rejection

The grounds for the obviousness rejection of claims 13 and 15-19 is set forth in part 5 on pages 2-3 of the Office Action. The rejection relies only upon U.S. Patent No. 5,204,955 to Kagei to reject the claims. Applicants respectfully traverse the rejection because it is wholly inadequate to establish even a prima facie case that each and every one of the combination of features recited in claims 13 and 15-19 is suggested by the prior art.

A careful inspection of the obviousness rejection reveals that it repeats those features of independent claim 13 which are disclosed by Kagei. The following version of claim 13 includes underlining to indicate those features of claim 13 that the obviousness rejection indicates are not disclosed by Kagei:

13. A device comprising:

a power unit;
means for accepting an instruction for controlling said power unit from a managing computer via a network;
a power unit controlling controller for converting said instruction into a power unit control signal; and
means for performing control of said power unit based on said

power unit control signal from said power unit controlling controller.

The rejection acknowledges that "Kagei does not explicitly disclose (sic) that the test management is for controlling a power unit." Nevertheless, the rejection concludes that it would have been obvious "to recognize that the teaching of Kagei can also be implemented for testing a power unit" and "to include a power unit into the teaching of Kagei in order to provide an autonomous power unit test function."

As they have done previously, applicants wish to point out that claim 13 is not limited to "test management", "testing a power unit", or "an autonomous power unit test function". Rather, claim 13 recites control of a power unit. While the control recited in claim 13 may be exercised for purposes of a test, there are no testing limitations in claim 13.

Although Kagai may disclose test management and an autonomous test function of a subnetwork management system, the rejection improperly relies on the proposition "that the teaching of Kagei can also be implemented for testing a power unit". Applicants do not agree that the subnetwork management subsystem can be easily modified without undue experimentation to provide for control of hardware, such as a power unit. To the contrary, the "test object" to be controlled in Kagei is limited to software configurations, such as "test create" and "test delete" in a specified service. See, for example, col. 7, lines 13-67, and Figs. 7-10 of Kagei.

The Remarks in part 6 on pages 3-4 of the Office Action suggest that these disputed features of claim 13 are "obviously disclosed by Kagei, specifically wherein

it is stated that a service processor board having a processor independent from the computer to be managed for monitoring fault in the computer to be managed and controlling power of the computer and testing object." However, applicants cannot find any mention of a service processor board in Kagei. It appears that perhaps the Examiner has confused Kagei with the service processor board (SVP) disclosed in the specification of this application (see, for example, page 5, line 22, to page 7, line 11).

Moreover, the rejection cites no other reference which provides any suggestion or motivation for attempting to modify Kagei so as to provide for testing of the power unit. To the contrary, it is this application which states the advantages of the device recited in claim 13. In other words, there would be no reason to suggest that Kagei should be modified in the manner proposed in the rejection were it not for the hindsight provided by this application.

According to the Manual of Patent Examining Procedure (MPEP), a secondary reference must be cited to support an obviousness rejection based upon the modification of Kagei. Absent such a secondary reference, the rejection of claim 13 fails to establish even a *prima facie* case of obviousness and should be withdrawn.

Claim 15

The rejection never refers to the feature recited in dependent claim 15. Kagei may disclose a server to be managed. However, in addition to the reasons set forth

above with respect to claim 13 arguing that Kagei does not make it obvious to control the power unit of a device, applicants also respectfully submit that it is even less obvious to control the power unit of a server. Typically, it is the client computer in a client/server network which is controlled rather than the server.

Claims 16-18

Claim 16 is dependent on claim 13 and recites the further feature that the power unit controlling controller comprises hardware. In addition to the reasons set forth above with respect to claim 13, applicants can find no suggestion of a hardware power unit controlling controller in Fig. 45 of Kagei, the only figure which appears to show any hardware features of subnetwork management system 20, and can find no suggestion of the recited combination of features in claim 16 including the hardware power unit controlling controller.

Claims 17 is the same as claim 15, except that it is dependent on claim 16 instead of claim 13. Applicants respectfully submit that claim 17 is allowable for at least the same reasons as set forth above for claims 15 and 16.

Claims 18 and 19 are dependent on claim 16 and recite additional features relating to the hardware power unit controlling controller. Applicants respectfully submit that claims 18 and 19 are allowable at least because these additional features are not suggested by Kagei and that the combination including these additional features is not suggested by any of the cited references.

New Claim 20-23

In addition to the reasons set forth above with respect to independent claim 13, applicants respectfully submit that new claims 20-23 (each of which are dependent on claim 13) are also allowable because of the additional features recited therein. These features relate specifically to the supply of power to a central processing unit in the device.

To the extent necessary, Applicants petition for an extension of time under 37 CFR § 1.136. Please charge any shortage in fees due in connection with the filing of this paper, or credit any overpayment of fees, to the deposit account of Antonelli, Terry, Stout & Kraus, LLP, Deposit Account No. 01-2135 (500.34601CC3).

Respectfully submitted,

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